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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,230	09/28/2001	Charles W. Shattuck	091395-9194 (4132-TC-AU)	5871
23409	7590	05/23/2005	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			HANSEN, COLBY M	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,230

Applicant(s)

SHATTUCK ET AL.

Examiner

Colby Hansen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Condon, Jr. et al. (US Pat. 3,930,692).

Condon, Jr. et al. (US Pat. 3,930,692) discloses a thrust bearing with needle rollers 36, the thrust bearing comprising: a first race component 32 made of a first material and including a flat, circular raceway portion, defined about an axis, and an axially extending lip portion; a plurality of needle rollers 36 arranged radially with respect to the axis for rolling contact with the flat raceway portion of the first race component; a bearing cage 34 retaining the needle rollers 36 and engageable with the lip portion of the first component (figs. 3 & 4) for piloting of the bearing cage 34; and a second race component 22 made of a second material and including a flat portion in contact with the raceway portion of the first race component and, also, including a lip portion 44,50 extending axially and radially from the flat portion and beyond the lip portion of the first race component such that the second race component 22 is engageable by the bearing cage 34 to hold the first race component 32, the second race component 22 and the bearing cage 34 together as an assembly; wherein the axially extending lip portion of the first race component 32 is radially outward of the raceway portion of the first race component 32;

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wherein the axially extending lip portion of the first race component is radially inward of the raceway portion of the first race component; further comprising an additional thrust race including a circular raceway portion for rolling contact with the rollers 36, the rollers 36 being positioned between the circular raceway portions of the first race component 32 and the additional thrust race; wherein the additional thrust race comprises two components 12, 46, 48 made of different materials (as broadly recited, the aforementioned limitation is interpreted as the two components are different parts, occupy different space, thus they utilize different materials from one another); wherein the additional thrust race is engageable by the bearing cage to retain the additional thrust race 46 and the bearing cage 34 together as an assembly wherein the second race component 22 is staked 40,44, at a plurality of locations along a circumference of the lip portion of the second race component (fig. 1), over the lip of the first race component, such that the first race component 32, the second race component 22 and the bearing cage 34 are retained together as an assembly; wherein the second race component 22 includes an extension portion 17,20,26 extending axially from the flat portion of the second race component 22 and in a direction away from the rollers; wherein the first and second race components are formed from sheet metal, the first and second materials being different from each other (as broadly recited, the aforementioned limitation is interpreted as the two components being different, autonomous parts, thus they utilize different materials).

Condon, Jr. et al. (US Pat. 3,930,692) discloses the claimed invention except for the first and second race components being made of specific material having certain characteristic with respect to one another.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized high carbon, bearing quality steel for the first race component, and more ductile and easily welded low carbon steel for the second race component, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed 3/2/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant also argues that there would be no motivation to modify the different elements of Condon, Jr. et al, such that the first and second bearing components would be of a different ductility. Examiner disagrees, and as alluded to in the explanation of the In re Leshin modification, the motivation is set forth by the suitability of the material for the intended use. For instance, such a modification may be necessary dependent upon the environment the bearing

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is to used (e.g. kiln bearing, snow track wheel bearing); Furthermore, the method of manufacturing may necessitate different materials to aide in the assembly such that inserting one component into the confines of the other component may be facilitated easier, thereby reducing cost. The motivation could be as simple as cost, such that a structure requiring less ductility could use a less costly (less ductile) material. Moreover, applicant has provided no evidence as to the criticality of this claim limitation. Therefore it is deemed that determining the physical material requirements (ductility, tensile strength, hardness, conductivity, etc.) suitable to an inventions intended use, method of manufacturing, etc. is a cornerstone of basic engineering, and clearly obvious.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MEP. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

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Responses submitted by facsimile transmission should include a Certificate of Transmission (MEP. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____

(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MEP. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colby Hansen whose telephone number is (571) 272-7105. The examiner can normally be reached on Monday through Thursday and every other Friday from 7:30 PM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (571) 272-7099. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Colby M. Hansen

Patent Examiner

 5/16/05


DAVID A. BUCCI
SUPERVISORY PATENT EXAMINER
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